

REMARKS

Claims 1-67 are pending. Claims 1-18, 20 and 25-66 have been cancelled. Claims 19, 21-24 and 67 have been amended. Claims 68-70 have been added. No new matter is introduced by way of these amendments and support for the added subject matter can be found throughout the specification and in the claims as originally filed. Reconsideration of the pending claims is hereby requested.

Specification

The Office has objected to the specification because it contains a reference to an ATCC designation without corresponding numbers. See, for example, page 15, section c, and page 70. The specification has been reviewed and appropriate amendments have been made to correct this error.

The Office also objected to the specification for containing an embedded hyperlink or other form of browser-executable code. The specification has been reviewed and the objectionable material has been removed.

Written Description

Claims 19, 21-24 and 67 were rejected under 35 U.S.C. § 112, first paragraph for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the relevant art that the inventors were in possession of the invention at the time the application was filed. Applicants respectfully disagree.

The present specification contemplates the use of the protein designated 158P1D7 and proteins related thereto as an immunogen with which to raise or elicit an immune response. Applicants believe that the detailed description of the 158P1D7 protein as well as variants of that protein provide sufficient support to allow a skilled artisan to reasonably conclude that Applicants were in possession of the full scope of the claimed invention at the time the application was filed. Nevertheless, solely to advance the prosecution of the pending claims, Applicants have amended the pending claims to relate to the protein defined by SEQ ID NO: 656, the nucleotide encoding that protein, or particular types of epitopes present in the claimed sequence. Applicants submit that

these amendments are more than sufficient to obviate the grounds of the present rejection. Accordingly, Applicants request that this rejection be withdrawn.

Enablement

Claims 19, 21-24 and 67 were rejected under 35 U.S.C. § 112, first paragraph for allegedly not being supported by an enabling disclosure. “To be enabling, the specification of a patent must teach those skilled in the art to make and use the full scope of the claimed invention without ‘undue experimentation’ ... Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative examples.” *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993).

Applicants respectfully submit that the pending claims are adequately supported by the present specification such that one of ordinary skill in the art would readily be able to practice the full scope of the claimed invention without undue experimentation. Moreover, Applicants reject the position of the Office that the “true” state of the art of peptide chemistry is accurately encompassed by the Lazar article, which was published approximately 10 years before the filing of the present application. Numerous developments that have occurred during the intervening years undermines the observation by the Office that Lazar represents the “true” state of the art of peptide chemistry as it existed at the time the present application was filed. Nevertheless, in view of the amendments made to the pending claims discussed above, the claims of this application now recite the protein defined by SEQ ID NO: 656, the nucleotide encoding that protein, and particular types of epitopes present in the claimed sequence. As such, Applicants submit that one of ordinary skill in the art could even more easily practice the claimed invention without undue experimentation. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Definite and Particular

Claims 19, 21-24 and 67 were rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants’ regard as the invention. The Office raised to grounds of rejection for the pending claims. The Office first alleged that recitation of the terms “158P1D7” and “158P1D7-related proteins” in claims 19, 21 and 22 are vague and indefinite. The Office then alleged that claims 19

and 67 were vague and indefinite in view of the recitation “at least a portion of an 158P1D7-related protein” and “portion”. Each of these rejections is addressed below.

Although Applicants respectfully disagree with the Office regarding the recitation of the terms “158P1D7” and “158P1D7-related proteins”, the pending claims have been amended to recite particular sequence identification numbers. As such, the amended claims are sufficiently definite to permit one of ordinary skill in the art to determine the metes and bounds of the claims.

Accordingly, Applicants request that this rejection be withdrawn.

Regarding the rejection in view of the term “portion”, in the course of clarifying the subject matter of the pending claims, the language that the Office based the present rejection has been deleted from the claims. This language has been replaced with a reference to an immunogenic composition comprising a T cell or B cell epitope. As one of ordinary skill in the art would readily be able to ascertain which portions of the claimed molecule comprise such epitopes, Applicants submit that the clarified language of the claims is sufficient to allow a skilled artisan to determine the metes and bounds of the claimed invention. Accordingly, Applicants request that this rejection be withdrawn.

Novelty

Claims 19, 21-24 and 67 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by United States Patent Application Publication No. 2004/0033504 and separately by WO 01/81363. “Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ... There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

The subject matter of the pending claims has been amended to recite particular sequence identification numbers, which correspond to particular amino acid and nucleotide sequences. As noted by the Office in the present Action, the cited references teach sequences that differ from those disclosed as SEQ ID NOS: 656 and 657. Because the cited art does not teach all the limitations of the claimed invention, it cannot anticipate the pending claims. As such, Applicants request that the

present rejection in view of the cited references United States Patent Application Publication No. 2004/0033504 and separately by WO 01/81363 be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 511582005000. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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